

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of :
Ernst Ludwig Kirchner AG : **RESPONSE TO OFFICE ACTION**
Serial No. 79/039,528 : **DATED AUGUST 2, 2007**
Filed: March 28, 2007 :
For Mark: ELK and Design
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BOX RESPONSES – NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Attention: **Benjamin U. Okeke, Esq., Trademark Attorney, Law Office 112**

This is Applicant's Response to the office action dated August 2, 2007.

AMENDMENT

1. **Identification of Goods and Services:**

Please amend the current identification of goods and services as follows:

BLEACHING PREPARATIONS AND OTHER SUBSTANCES FOR LAUNDRY USE;
COSMETICS, **INCLUDING**, SOAPS, PERFUMERY, ESSENTIAL OILS, HAIR
LOTIONS, DENTIFRICES in Class 3;

TABLE CUTLERY in Class 8;

PRE-RECORDED COMPACT DISCS, COMPUTER PROGRAMS,
PHOTOGRAPHIC SLIDE TRANSPARENCIES, **BLANK MAGNETIC DISCS**,
MAGNETICALLY ENCODED CREDIT CARDS, **EXPOSED SLIDE**,
PHOTOGRAPHIC AND CINEMATOGRAPHIC FILMS, **PRECORDED VIDEO**
CASSETTES, **PRE-RECORDED** OPTICAL COMPACT DISCS in Class 9;

PRECIOUS METALS AND THEIR ALLOYS AND GOODS MADE OF THESE
MATERIALS OR PLATED THEREWITH INCLUDED IN THIS CLASS,
JEWELLERY, LAPEL PINS, PRECIOUS STONES, HOROLOGICAL AND
CHRONOMETRIC INSTRUMENTS in Class 14;

PAPER; CARDBOARD; PRINTED MATTER; BOOK BINDING MATERIALS;
PHOTOGRAPHS, STATIONERY, POSTERS, MATERIALS FOR ARTISTS;
CALENDARS, BOOKS in Class 16;

LEATHER AND IMITATION LEATHER, GOODS MADE THEREOF INCLUDED IN
THIS CLASS; SATCHELS, TRUNKS AND SUITCASES, UMBRELLAS; **AND**
PARASOLS in Class 18;

HOUSEHOLD OR KITCHEN CONTAINERS; HOUSEHOLD OR KITCHEN
UTENSILS; **BEVERAGE** GLASSWARE, PORCELAIN AND EARTHENWARE in
Class 21;

FABRICS AND TEXTILES **IN THE NATURE OF GIFTS**, **TEXTILE WALL**
HANGINGS, TABLE AND BED **LINENS** in Class 24;

CLOTHING, FOOTWEAR, HEADWEAR, TIES, SILK SCARVES in Class 25;

CARPETS, RUGS, MATS AND MATTING, LINOLEUM AND OTHER MATERIALS
FOR COVERING EXISTING FLOORS; **NON-TEXTILE** WALL HANGINGS in Class
27;

GAMES, TOYS, GYMNASTICS AND SPORTING ARTICLES in Class 28;

COFFEE, TEA, COCOA, CEREAL PREPARATIONS, **NAMELY, CEREAL-BASED**
SNACK FOODS AND BREAKFAST CEREALS; BREAD, PASTRY AND
CONFECTIONERY; EDIBLE ICES in Class 30;

ADVERTISING **SERVICES**; BUSINESS MANAGEMENT IN CONNECTION WITH
MERCHANDISING GOODS in Class 35;

PROVIDING MUSEUM FACILITIES; **ORGANIZING** CULTURAL ACTIVITIES in
Class 41;

SERVICES FOR PROVIDING **OF** FOOD AND DRINK; **PROVIDING** TEMPORARY ACCOMMODATION in Class 43;

LICENSING OF INTELLECTUAL PROPERTY in Class 45.

2. Entity:

Please amend the application to reflect that Applicant Ernst Ludwig Kirchner AG is a Company organized in Switzerland.

REMARKS

I. LIKELIHOOD OF CONFUSION

The Trademark Attorney has refused to register Applicant's mark ELK and Design on the ground that the mark is likely to be confused with the registered marks ELK, Registration No. 3,001,931, owned by Elk Premium Building Products, Inc., covering "polyester fabrics used for filtration" in Class 24 and two registrations for GRAND ELK, Registration Nos. 3,177,589 and 3,340,417 (which issued from cited application Serial No. 76/265,764), owned by Grand Elk, LLC, covering a variety of goods and services related to golf club, skiing and resort hotel services including goods in Classes 14, 18 and 21 and food services in Class 42 (the "Cited Registrations").¹ The Trademark Attorney states that Applicant's mark and Applicant's goods and services in Classes 14, 16, 18, 21, 24, 25, 28 and 43 are identical and/or substantially similar to the Cited Registrations and Applicant's and therefore the marks are likely to be confused. However, Applicant respectfully submits that the Trademark Attorney has failed to account for the meaning and context of Applicant's mark, namely that Applicant's ELK mark is a monogram

¹ Applicant notes that the Trademark Attorney cited a potential likelihood of confusion with Application Serial No. 76/640,992 but as seen from the TARR print-out attached as Exhibit A, that application has been abandoned and the citation is therefore moot.


for the late renowned artist Ernst Ludwig Kirchner, which greatly distinguishes its mark from the Cited Registrations which use the word ELK to suggest the animal. Furthermore, the goods and services covered by the Cited Registrations are not similar or related to Applicant's goods and services since purpose and context for the goods and services are distinguishable. Finally, the term ELK is frequently used in marks co-existing on the register, including for the relevant goods and services, and those marks are more similar to the Cited Registrations, since they too use ELK in its meaning as the animal, than to Applicant's mark and its reference to the artist.

A. The Context of Applicant's Mark Sufficiently Distinguishes Its Mark and Its Goods and Services from the Cited Registrations

Applicant, Ernst Ludwig Kirchner AG, takes its name from the famous German expressionist artist Ernst Ludwig Kirchner who founded the "Die Brücke" art movement in the early 20th century. See Exhibit B (biography of the artist and samples of his work). Ernst Ludwig Kirchner's works are widely collected and shown today, bringing much renown to his work and career. His work has been collected and/or exhibited by many of the world's finest museums and galleries including over twenty museums in the United States, including, the Museum of Modern Art in New York, the Art Institute of Chicago, the Guggenheim Museum in New York, the Museum of Fine Arts in Boston, the National Gallery of Art in Washington DC, the Los Angeles County Museum of Art, the Fine Arts Museum of San Francisco, the Carnegie Museum of Art in Pittsburgh, the North Carolina Museum of Art, the Norton Simon Museum in Pasadena and the Neue Galerie in New York. See Exhibit C (listing of museums displaying and/or collecting artist's work). Given this widespread exposure to his work, Ernst Ludwig Kirchner is well-known in the art world and to art lovers throughout the country. Applicant's goods and services are centered around the provision of museum facilities and cultural activities

as well as a broad range of merchandising goods which will promote the artist's name. As the Trademark Attorney is aware, Applicant owns a pending application for the ERNST LUDWIG KIRCHNER mark and name, Serial No. 79/039,529, which makes this clear. The present



application for the mark , is intended to reflect the artist's monogram and contains stylized elements which make the monogram appear as if it had been painted by the artist.

Therefore, the public, familiar with the artist and his work, will understand that Applicant's ELK and Design mark is the artist's monogram and will understand Applicant, Ernst Ludwig Kirchner AG, to be the source of the artist-related merchandise and services.

In contrast, the Cited Registrations both use the word ELK in their marks to refer to the elk animal. For instance, attached as Exhibit D is a page from the cited registrant Grand Elk, LLC's ("Grand Elk's") web site as well as an article discussing the GRAND ELK RANCH & CLUB in Colorado with its ski facilities and PGA designed golf course. As seen from these pages, Grand Elk's logo features the profile of an elk so consumers will clearly understand that the word ELK in its GRAND ELK mark refers to the animal. Furthermore, as seen from these pages, Grand Elk's primary business is the provision of resort and real estate services centered around its skiing and golfing activities. The other goods and services covered by Grand Elk's registrations merely promote the primary business and thus consumers will understand those goods and services have Grand Elk as their source.

Likewise, the cited registration owned by Elk Premium Building Products, Inc. ("Elk Premium") in context uses its ELK mark to refer to the animal. As seen from pages from Elk Premium's web site attached as Exhibit E, Elk Premium uses its ELK mark with the image of a

leaping elk. Thus, Elk Premium's consumers will clearly understand the meaning of its ELK mark. Moreover, as made clear in Elk Premium's description of goods and made clear on its web site, Elk Premium's fabric is a specialty, technical filtration product which is used by contractors including as flooring underlayment or a fire barrier. This special, technical product will not be confused with Applicant's Class 24 gift, bed and table products which are used to promote the Ernst Ludwig Kirchner legacy.

Since the Cited Registrations use the term ELK in its meaning as an animal while Applicant's mark is clearly in context a highly stylized monogram for the well-known artist Ernst Ludwig Kirchner, the relevant public will not be confused as to the source of Applicant's ELK and Design goods and services. Furthermore, since Applicant's goods and services are all related to promotion of the artist and his legacy while Grand Elk's goods and services are related to promotion of a golf and ski resort and Elk Premium's goods are specialized filtration fabric for contractors, Applicant's goods and services are sufficiently distinguishable from the goods and services covered by the Cited Registrations.

B. The Trademark Office Has Recognized Consumers are Able to Distinguish Between Different Uses of the Term ELK

The Trademark Office has regularly allowed the Cited Registrations to co-exist with approved applications and registrations for marks containing the term ELK, used to mean the animal. While Elk Premium's registration covers highly specialized goods, which are very distinguishable from Applicant's goods and the goods of others, as discussed above, a number of approved applications and registrations cover identical or very similar goods and services as those provided by Grand Elk. These applications and registrations include:

<u>Mark</u>	<u>Reg./App. No.</u>	<u>Relevant Goods or Services</u>
ELK VALLEY RESORT & CASINO	78/636,477	Jewelry in Class 14 Printed matter in Class 16 Beverage ware in Class 21 Apparel in Class 25 Toys in Class 28 Golfing services in Class 41 Hotel and food services in Class 43
ELK VALLEY RANCHERIA	76/978,768	Jewelry in Class 14 Printed matter in Class 16 Beverage ware in Class 21 Golfing services in Class 41
ELK VALLEY RANCHERIA	76/634,620	Apparel in Class 25 Toys in Class 28 Hotel and food services in Class 43
TWIN ELK and Design	2,339,672	Jewelry in Class 14* Beverage glassware in Class 21* Apparel in Class 25* Retail shops featuring clothing and jewelry in Class 35 *Although these classes have since been cancelled from the registration, they were active at the time Grand Elk's registrations were approved
ELK MOUNTAIN and Design	1,485,221	Jewelry in Class 14 Clothing in Class 25 Ski resort services in Class 41
ELK CREEK and Design	2,312,459	Jewelry in Class 14 Diaries and daily planners in Class 16* Leather goods in Class 18* Clothing in Class 25*

		*Although these classes have since been cancelled from the registration, they were active at the time Grand Elk's registrations were approved
ELK RIVER and Design	2,653,995	Recreational services in the nature of a golf course in Class 41
ELK'S KEY	2,634,944	Golf teaching aid in Class 28
ELK WOODS	3,209,198	Footwear in Class 25
WITCH-ELK	3,192,381	Sneakers, t-shirts, hats, sweatshirts in Class 25
ELKHORN	2,801,167	Clothing, namely, shirts in Class 25
ROCKY MOUNTAIN ELK FOUNDATION	2,812,083	Drinking glasses in Class 21 Clothing in Class 25
ELK SONG	2,727,764	Clothing, namely, coats and jackets in Class 25
ELKLAND and Design	1,477,843	Men's work shoes in Class 25
ELK RIVER and Design	1,398,633	Footwear in Class 25

See Exhibit F (copies of TARR print-outs for listed marks). As shown above, use of the word ELK for apparel, jewelry and beverage ware, some of the items singled out by the Trademark Attorney, is frequent and overlapping. More importantly, the GRAND ELK marks, which cover a wide variety of merchandising goods in support of golf and ski resort services, are co-existing with a number of ELK VALLEY marks as well as a registration for ELK MOUNTAIN, which both use its ELK mark for golf or ski resort services as well as a line of merchandise promoting those services. The registrations for TWIN ELK and ELK CREEK also, like the GRAND ELK registrations, cover a wide variety of identical goods. Finally, despite the importance of golf to Grand Elk's goods and services, the Trademark Office has allowed GRAND ELK to co-exist with ELK RIVER and ELK'S KEY for golf goods or services. Therefore, if the cited GRAND ELK registrations may co-exist with other ELK marks that use ELK to mean the animal and cover merchandising programs, some directly related to golf and ski resort services, surely

Applicant's ELK and Design mark, which clearly is a monogram for Ernst Ludwig Kirchner, can similarly co-exist.

II. Identification of Goods and Services and Applicant Entity Information

The Trademark Attorney has also requested certain clarifications in the identification of goods and services covered by the present application as well as in the owner entity information provided by the Applicant. Applicant has now clarified that it is a Swiss company and it has also made certain amendments to the identification of goods and services in accordance with the Trademark Attorney's suggestions. Applicant understands that the Trademark Attorney may have further concerns regarding the identification of goods and services and it would be happy to discuss those concerns with the Trademark Attorney further.

CONCLUSION

Based on the foregoing amendments and remarks, Applicant believes that it has satisfied the Trademark Attorney's objections and respectfully submits that its mark ELK and Design should be passed to publication.

Dated: New York, New York
February 22, 2008

Respectfully submitted,

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